

REMARKS

Applicants thank the Examiner for rejoining claims 6 and 9 and for indicating that claims 1-16, 18-23, 27 and 28 are allowable. Applicants also thank the Examiner for the telephonic interview of December 8, 2008 providing clarification of the rejections.

After entry of this amendment, claims 1-16 and 18-28 are pending. Claim 24 has been amended without prejudice or disclaimer and the amendment finds support in the specification, for example, at page 10 line 33 through page 11 line 44, at page 13 line 37 through page 14 line 19, and at page 17, lines 1-11, 26-47. No new matter has been added.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 24-26 under 35 U.S.C. § 112, first paragraph, for allegedly lacking an enabling disclosure and for allegedly failing to comply with the written description requirement. Applicants respectfully traverse.

Enablement Rejection

The Examiner alleges that claims are drawn to any fragment obtained by testing variants of SEQ ID NO: 1 which have at least 90% sequence identity to SEQ ID NO: 1 (Office Action, page 3, lines 1-3). Applicants respectfully disagree. The claims do not recite “fragments.”

The Examiner bases the rejection on the recitation of “at least 90% identity” as clarified during the telephonic interview of December 8, 2008. Applicants respectfully disagree that the claims are not enabled. The specification teaches the preparation of derivatives of full-length promoter sequences, as well as methods of determining activity of such promoter sequences and exemplifies promoter function in multiple species. The Examiner also cites to Kim *et al.* for unpredictability of the function of promoter variants. Contrary to the Examiner’s assertion, as found by the Board in *Ex parte Heck*, Kim *et al.* rather demonstrates the routine nature of promoter analysis using standard methods to determine which sequence elements affect promoter strength and which elements have no impact. *Ex parte Heck*, Appeal 2008-2875 (BPAI 2008). Analogous to the holding by the Board in *Ex parte Heck*, the specification should be found

enabled. Nonetheless, in order to expedite prosecution, the claims have been amended without prejudice or disclaimer and do not recite "at least 90% identity." During the telephonic interview of December 8, 2008, the Examiner indicated that such an amendment would likely obviate the rejection. Accordingly, the rejection is believed to be rendered moot. Applicants respectfully request reconsideration in light of the amendment and withdrawal of the rejection.

Written Description

The Examiner bases the rejection on the recitation of "at least 90% identity" as clarified during the telephonic interview. Applicants respectfully disagree that the specification lacks written description. Analogous to the holding in *Ex parte Heck*, the specification explicitly teaches the structure of promoter sequences by providing the nucleic acid of SEQ ID NO: 1 and the skilled artisan would know the structure, *i.e.* at least 90% identity to SEQ ID NO: 1, as well as the function of having promoter activity. Moreover, the specification teaches the preparation of derivatives of full-length promoter sequences, as well as methods of determining activity of such promoter sequences and exemplifies promoter function in multiple species. Nonetheless, in order to expedite prosecution, the claims have been amended without prejudice or disclaimer and do not recite "at least 90% identity." During the telephonic interview of December 8, 2008, the Examiner indicated that such an amendment would likely obviate the rejection. Accordingly, the rejection is believed to be rendered moot. Applicants respectfully request reconsideration in light of the amendment and withdrawal of the rejection.

CONCLUSION

For at least the above reasons, Applicants respectfully request withdrawal of the rejections and allowance of the claims. If any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number given below.

This response is filed within the three-month period for responding from the mailing date of the Office Action of November 24, 2008, to and including February 24, 2009. No fee is believed due.

However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13173-00008-US from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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